



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,170	10/30/2001	Louis B. Rosenberg	IMM1P027B	1999

22903 7590 03/14/2006

COOLEY GODWARD LLP
ATTN: PATENT GROUP
11951 FREEDOM DRIVE, SUITE 1700
ONE FREEDOM SQUARE- RESTON TOWN CENTER
RESTON, VA 20190-5061

EXAMINER

BRIER, JEFFERY A

ART UNIT	PAPER NUMBER
----------	--------------

2672

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/004,170	Applicant(s) ROSENBERG ET AL.	
	Examiner Jeffery A. Brier	Art Unit 2672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53,55,56,61,66 and 69-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53,55,56,61,66 and 69-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 7/27/2004 has been entered.

Information Disclosure Statement

2. The information disclosure statement filed 07/27/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but certain of the information referred to therein has not been considered.

PTO-SB/08A 1 of 2 consisting of sheets 1 to 3:

The US patents have been considered while being viewed in EAST.

The foreign patents and the Non-Patent Literature have not been considered because they are not present in the IFW file. Copies were provided on CDROM, however, this is not a current proper method of providing the articles since the scanner

cannot scan them into IFW. The proper method to provide these articles is to provide paper copies of those articles so they can be scanned into the IFW file and then considered by the examiner. In addition the document numbers given for the foreign documents do not appear to be correct Japanese document numbers.

PTO-SB/08A 2 of 2 consisting of one sheet:

These documents were considered since they were cited in the parent applications.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 53, 55, 56, 61, 66, and 69-101 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In view the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility published on the USPTO website on October 26, 2005,

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

and published in the OG 22Nov2005

<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>.

Art Unit: 2672

the following 35 USC 101 rejection is now required because practical application of the claimed filtering is not present in the claims. On pages 20-22 and 37-39 of the pdf version of the Interim Guidelines practical application and useful, tangible, and concrete results are discussed. Claim 53 claims "produce the input data operative to reduce visual disturbance in the associated graphical environment". Claim 55 claims "produce the filtered input data operative to reduce visual disturbance in the associated graphical environment". Claim 56 claims "produce the input data being operative to reduce visual disturbance in the associated graphical environment". Claim 61 claims "the filtering of the sensor data operative to reduce visual disturbance in an associated graphical environment caused by the output of haptic feedback". Claim 66 claims "a filter configured to receive sensor data from the sensor and to provide input data to an associated graphical environment". Each of these claims fail to claim a real world practical application due to their brevity. In claims 53, 55, 56, and 61 the terms "operative", "reduce visual disturbance", and "associated graphic environment" does not provide sufficient real world application for the "filtering sensor data" step. In claim 66 a practical application for the "filter" and the input data" is not present. Dependent claims 69-77, 79-84, 86-91, 93-98, 100, and 101 do not further define the allege application of the filtered signal. Dependent claims 78, 85, 92, and 99 claim "updating a position of a graphical object in the associated graphical environment based on the input data" which does not correlate the visual disturbance to the graphical object. In claims 53, 55, 56, and 61 and their dependent claims the "filtering sensor data" is not positively correlated to the haptic-feedback device such that a practical application of "filtering sensor data"

Art Unit: 2672

and the "reduce visual disturbance in the associated graphical environment" is not present. In re Alappat 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994). State Street Bank & Trust Co. v. Signature Financial Group Inc. (CA FC) 47 USPQ2d 1596, 1603 (7/23/1998). AT&T Corp. v. Excel Communications Inc. (CA FC) 50 USPQ2d 1447.

On page 1603 first paragraph the CAFC wrote in State Street:

Under Benson , this may have been a sufficient indicium of nonstatutory subject matter. However, after Diehr and Alappat , the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter, unless, of course, its operation does not produce a "useful, concrete and tangible result." Alappat , 33 F.3d at 1544, 31 USPQ2d at 1557. 7

On page 1603 paragraph labeled [4] the CAFC wrote:

[4] The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter-- but rather on the essential characteristics of the subject matter, in particular, its practical utility. Section 101 specifies that statutory subject matter must also satisfy the other "conditions and requirements" of Title 35, including novelty, nonobviousness, and adequacy of disclosure and notice. See In re Warmerdam , 33 F.3d 1354, 1359, 31 USPQ2d 1754, 1757-58 (Fed. Cir. 1994).

Therefore the claims need to be amended to clearly claim a practical application of filtering the sensor data generated by the haptic-feedback device while the haptic-feedback device is generating haptic-feedback to the user.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

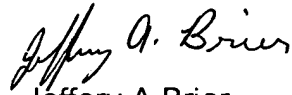
6. Claims 55 and 79-85 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At line 6 of claim 55 "the associated graphical environment" lacks antecedent basis in the claim, note previously in the claim "an associated graphical environment" was deleted. At lines 8-9 of claim 55 "an associated graphical environment" is claimed which makes this part of the claim unclear if a new associated graphical environment is being claimed or actually reference was intended to be made to the previously claimed associated graphical environment.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:00 to 3:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 2672

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Jeffery A. Brier". The signature is written in a cursive, flowing style.

Jeffery A Brier
Primary Examiner
Art Unit 2672